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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,259	07/24/2003	Zhong Ding	961_013NP	9582
20874 7590 09/26/2007 MARJAMA MULDOON BLASIAK & SULLIVAN LLP 250 SOUTH CLINTON STREET SUITE 300 SYRACUSE, NY 13202			EXAMINER GORDON, BRIAN R	
			ART UNIT 1743	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/626,259	Applicant(s) DING ET AL.	
	Examiner Brian R. Gordon	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7-12-07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6,9 and 11-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 9, 11-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date = | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1, 6, 9, 11, and 13-17 have been considered but are moot in view of the new ground(s) of rejection.

While Hughes specifies the cap is plastic (column 3, line 52), it is not specifically recited that the plastic material is transparent or clear. However, it should be noted that the reference does not state the cap is not clear or transparent as asserted by applicant.

It would have been obvious to one of ordinary skill in the art at the time of the invention to recognize the plastic material of the cap maybe transparent. It is conventionally known that plastic materials maybe transparent. For example, as admitted by applicant the syringe and bottle of Hughes is manufactured from a clear, plastic material (column 3, line 6)

Applicant continues to arguer there is some distinction in the claimed "read window" and that of the prior art. Throughout the prosecution of the applicant, the examiner has specifically and adequately addressed this issue and provided a detail explanation as how the element has been interpreted and how the prior art meets such the limitation (see prior Office Action 5/01/2007at pages 2-4; Interview Summary 3/14/07). The examiner maintains the same position as previous stated. Applicant device is a single body made of transparent material. Any portion that allows light to pass through may be referenced as a window. Applicant simply chooses to refer to such a portion as a "read window". However, there is no structural difference between the area applicant chooses to reference as a "read window" any other portion of the

walls of the device. For example, a window of a house can clearly be distinguished in numerous ways from the remaining portion of the walls of the house. The window of a house can clearly be seen as a structure of specific dimensions and separable from the wall. The window is also most often made of different material from the remaining portion of the wall. As stated above, there is no distinction from the portion of applicant's device referenced as a read window and the remaining portion of the device. The device is an integral, one-piece, transparent device. It's similar to having a single pane of glass of specified dimensions, and one chooses to refer to a smaller area within the larger area as a window. Any portion of the large pane may be referenced as a window.

As to the portion of the device references as a read window being cylindrical, it is clearly seen from the cross-sectional view of the figures the device is cylindrical.

Furthermore figures also illustrate interior stepped areas as now recited in the amended claims.

Applicant's arguments directed to the 103 rejection of claims 1 and 6 Lukacs et al., and Treptow et al. are based upon intended use. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. The device can be used in any manner one chooses. The fluid that one chooses to dispense from the device does not change the structure.

In view of such, it is only required that the prior art disclose a body with a cylindrical portion that allows for light to pass or the interior contents to be seen,

detected, or measured through the wall (which is equivalent to the read window as claimed and disclosed in the specification).

As to the 103 rejection of claims 1 and 6 as based upon Lukacs et al. and Treptow et al, the examiner previously directed applicant's attention specifically to Figure 6 of Lukacs that illustrates a cross-section of the dispenser 12 that clearly shows the tapered, cylindrical, axial portions, steps, and tip openings as claimed by applicant. The drawing alone is sufficient to show the elements (all except for a window). Further details directed to the invention of the reference are disclosed in columns 1-4.

In terms of the method, Hughes discloses the device is employed for fluid testing, but does not disclose the cap/tip device as being employed for optical analysis.

Applicant asserts there is no reasonable expectation of success of the combination. The examiner disagrees. As previously stated, and disclosed in Treptow et al. On the spot optical analysis of a fluid can be performed in a tip of a device such as that disclosed by Hughes.

As to the "latching" and "minimizing of oscillation" affect of a fluid mentioned in the apparatus claims, it should be noted the fluid is not an element of the device. Furthermore the claims recited a desired affect one would like to achieve when using the device. The desired affects are not considered further limiting of the structure. Whether or not the device actually does achieve such affects would not only be determined by the structure but would depend upon a number factors, for example such as the properties of the fluid used with tip, pressure exerted in the tip, direction of flow,

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and velocity of the fluid used therein. Unless otherwise stated, it is inherent that an equivalent structure would be capable of such affects.

The claims are rejected as given herein.

Drawings

2. The drawings were received on July 12, 2007 wings are acceptable

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 6 and 16-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 6 describes the read window. There is no support for the area of the tip which applicant regards at the read window as being "planar" and of "constant diameter" as claimed. The portion comprising applicant's "window" 96 appears to be conical or tapered as illustrated in Figure 12.

Claim 16 suggests a method comprising the steps of aspirating a first a fluid volume from a source, dispensing portions of said first volume to one reaction device, and subsequently aspirating the remaining portions of the first fluid volume into the tip. How can one aspirate the remaining portions of the initial fluid when the previous step

already establishes the initial volume has already been aspirated? Where is there support for such a method?

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 6, 9, and 11, 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes US 3,449,081.

Hughes discloses a tapered, plastic cap (tip) that includes upper and lower openings and stepped portions therein (see Figures 4 and 6). As given herein above, the examiner asserts the device of Hughes is equivalent to the claimed structure.

While Hughes specifies the cap is plastic (column 3, line 52), it is not specifically recited that the plastic material is transparent or clear. However, it should be noted that the reference does not state the cap is not clear or transparent as asserted by applicant.

It would have been obvious to one of ordinary skill in the art at the time of the invention to recognize the plastic material of the cap maybe transparent. It is conventionally known that plastic materials maybe transparent. For example, as admitted by applicant the syringe and bottle of Hughes is manufactured from a clear, plastic material (column 3, line 6)

As to claims 9 and 11, the cap is attached to a bottle (metering apparatus) fluid is aspirated and dispensed from such cap. Since the cap is structurally equivalent the affects of such structure on moving fluid as recited would be inherent..

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huhges as applied to claims 1, 6, 9, 11, 13-17 above, and further in view of Treptow et al. US 5,844,686.

While the cap is disclosed as being manufactured of a plastic, the reference fails to specify that the plastic is transparent.

Hughes does not disclose the plastic cap being employed in a method consisting of performing a spectrophotometric read of fluid in the cap (claim 12).

Treptow et al. disclose an apparatus for pipetting and photometrically evaluating samples which comprise a pipetting means, an integrated photometer and a replaceable pipette tip connected to said pipetting means, said pipette tip being defined as a cell and provided within the optical path of the photometer for photometrically evaluating absorbed samples (abstract).

The pipette tip 4 within the area of the optical path 6, 7 comprises two plane-parallel windows 8, 9 on opposite sides of its wall.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the cap/tip of Hughes et al to incorporate the optical windows as taught by Treptow in order to provide a cap of test kit to allow for "on-the-spot"-analytics of the samples.

As to the method claims, it would have been obvious to one of ordinary skill in the art to recognize that upon aspirating and dispensing fluid in or from the modified structure of Hughes, the same steps (or effects on the liquid) of the claimed method would occur.

6. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lukacs et al., US 3,780,935 and Treptow et al.

Lukacs et al. discloses all of the claimed structural limitations (see figure 6) except for a read window.

Treptow et al. disclose an apparatus for pipetting and photometrically evaluating samples through a window.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the dispensing device of Lukacs et al to incorporate the optical windows as taught by Treptow in order to provide a cap of test kit to allow for "on-the-spot"-analytics of the samples.

It would have further been obvious to recognize the device maybe manufactured from conventional transparent material such as glass or plastic thereby establishing a read window.

Conclusion

7. No claims allowed.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, 1st Fri. Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian R Gordon/
Primary Examiner
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